



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,500	04/19/2004	Stuart Masfield Lay	105SR-015	3481

7590 09/08/2005  
Bradley N. Ruben, PC  
Suite 5A  
463 First St.  
Hoboken, NJ 07030-1859

EXAMINER

FRISTOE JR, JOHN K

ART UNIT	PAPER NUMBER
----------	--------------

3751

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/827,500	<b>Applicant(s)</b> LAY, STUART MASEFIELD	
	<b>Examiner</b> John K. Fristoe Jr.	<b>Art Unit</b> 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 1-5, 11 and 16 is/are rejected.
- 7) ☒ Claim(s) 6-10, 12-15 and 17-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 9 is objected to because of the following informalities: in line 2 "pivot7ting" should be replaced with "pivoting". Appropriate correction is required.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on 7/17/2003. It is noted, however, that applicant has not filed a certified copy of the 0316735.0 application as required by 35 U.S.C. 119(b).

### ***Drawings***

3. Figure 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102.***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3751

5. Claims 1-4, 11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,429,591 (Zuch et al.). Zuch et al. disclose a motorized valve actuator comprising a motor (17), an output shaft (1), a gear mesh (3 and 4, worm gears) which are incapable of being back driven, a manual drive having a hand wheel (10), a clutch (18), a lever (27), an intermediate shaft (5), wherein when the lever (27) is operated to bring the actuator into hand drive mode the clutch mechanism (18) operates substantially freely, wherein the output shaft torque generated by the previous motor (17) powered run and locked into the output shaft (1) by the no locking back driven gear mesh (3 and 4) not being locked into the clutch mechanism (the clutch mechanism rides on an intermediate shaft which is not directly connected to the handwheel or the motor), a gear reduction drive (12), a latch mechanism (29), and a static post (26).

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 4,429,591 (Zuch et al.) in view of U.S. Pat. No. 4,398,562 (Saarem et al.). Zuch et al. disclose a motorized valve actuator comprising a motor (17), an output shaft (1), a gear mesh (3 and 4, worm gears) which are incapable of being back driven, a manual drive having a hand wheel (10), a clutch (18), a lever (27), an intermediate shaft (5), wherein when the lever (27) is operated to bring the actuator into hand drive mode the clutch mechanism (18) operates substantially freely, wherein the output shaft torque generated by the previous motor (17) powered run and locked

Art Unit: 3751

into the output shaft (1) by the no locking back driven gear mesh (3 and 4) not being locked into the clutch mechanism (the clutch mechanism rides on an intermediate shaft which is not directly connected to the handwheel or the motor), a gear reduction drive (12), a latch mechanism (29), and a static post (26) but lacks a clutch made of plastic moldings. Saarem et al. teaches a valve actuator comprising a clutch (col. 2, lines 47-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the valve actuator of Zuch et al. by making the clutch from plastic as taught by Saarem et al. in order to make the clutch less expensive.

***Allowable Subject Matter***

8. Claims 20 and 21 are allowed.
9. Claims 6-10, 12-15, and 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

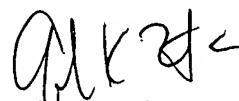
U.S. Pat. No. 4,453,624 (Graham) discloses an actuator with a plastic hand wheel.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Fristoe Jr. whose telephone number is (571) 272-4926. The examiner can normally be reached on Monday-Friday, 7: 00 a.m-4: 30 p.m.


Art Unit: 3751

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine R. Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John K. Fristoe Jr.  
Examiner  
Art Unit 3751

JKF

  
EDWARD K. LOOK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

9/2/05